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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,694	09/18/2006	Hiroshi Ujiie	P29320	4550
7055 7590 03/24/2010 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER DICKINSON, PAUL W				
ART UNIT 1618		PAPER NUMBER		
NOTIFICATION DATE 03/24/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

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# Office Action Summary

**Application No.**

10/568,694

**Applicant(s)**

UJIE ET AL.

**Examiner**

PAUL DICKINSON

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 17 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/CIS/6)  
Paper No(s)/Mail Date 9/26/2006 and 9/17/2009  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 6-8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what "expanded polytetrafluoroethylene" is. This term isn't defined by the specification. How would one determine if a certain polytetrafluoroethylene is expanded or not? Is there a baseline non-expanded polytetrafluoroethylene to compare expanded polytetrafluoroethylene to? Is expanded polytetrafluoroethylene a polytetrafluoroethylene with a certain volume? With a certain density?

It is unclear how silicone could be a polymer material containing carbon as a constitutional element. If "carbon as a constitutional element" means having carbon as the main element present, either by number or weight, most silicones would not fall into this category, and would not be considered "polymer materials containing carbon as a constitutional element". For example, many oligosiloxanes have the general formula  $R_nSiX_mO_y$ , where R is a non reactive substituent, usually Me, and X is a functional group such as H, OH, or Cl. In this case, as with most silicones, carbon is not the main element present, either by number or weight, and thus would not be considered a polymer material "containing carbon as a constitutional element".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 20020155295 ('295). '295 discloses a method comprising bombarding ions onto expanded polytetrafluoroethylene (ePTFE) (a polymer material containing carbon as a constitutional element) with a dose volume of  $1 \times 10^{13}$  to less than  $1 \times 10^{16}$  ions/cm<sup>2</sup> (see abstract; paragraphs 5-17; examples). This satisfies claims 1-2, 4-6, and 8-10. The acceleration energy is between 50 KeV to 150 KeV (i.e between 50 KeV to 0.150 MeV) (see paragraph 42). This satisfies instant claims 3 and 7.

The recitation "a material for treating aneurysms" is an intended use limitation. The recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, '295 discloses a material composed of a polymer material containing carbon as a constitutional element, produced by modifying at least a portion of the surface thereof by ion bombardment. The material of '295 meets all the structural requirements of the instant claims and is therefore fully capable of being used for the intended use, i.e. treating aneurysms.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5891192 ('192). '192 discloses a material for treating aneurysms (see abstract), which may be composed of a bioabsorbable polymer, such as poly-L-lactide (polylactic acid; a polymer material containing carbon as a constitutional element) (see col 2, lines 36-63), which is produced by modifying at least a portion of the surface thereof by ion bombardment (see col 1, line 56 to col 2, line 15). This satisfies claims 1-2 and 6. The dose volume may be  $1 \times 10^{15}$  ions/cm<sup>2</sup> (see col 4, lines 15-17). This satisfies instant claims 4-5 and 8-10. The acceleration energy may be about 10 KeV to 1000 KeV (see col 3, lines 15-28). This satisfies instant claims 3 and 7.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DICKINSON whose telephone number is (571)270-3499. The examiner can normally be reached on Mon-Thurs 9:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric E Silverman/  
Primary Examiner, Art Unit 1618

Paul Dickinson  
Examiner  
AU 1618

March 16, 2010